

## **REMARKS/ARGUMENTS**

### **Interview**

Applicants thank the Examiner for her courtesy and consideration in discussing this Application in a telephone interview on November 17, 2006. Because interviews after final are discretionary, Applicants especially appreciate the opportunity.

Specifically, aspects of claims 14, 22 and 28 were discussed in light of the 35 U.S.C. §103(a) rejection. Applicants pointed out a number of elements in the claims that were not taught in the reference. The Examiner conceded that certain issues raised by the applicants had merit, and that the art cited in the Final Office Action dated August 14, 2006 ("Final Office Action") was insufficient to teach the limitations in the claims.

The Examiner asked Applicants to prepare a response summarizing these issues, and agreed that she would consider an allowance and, at least, prepare a new Office Action.

### **Status of the Claims**

Before this Amendment, claims 1-14, 17-24, 26 and 28 were present for examination. No claims are amended, canceled, or added. Therefore, claims 1-14, 17-24, 26 and 28 are present for examination, and claims 1, 14, 22, and 28 are the independent claims. Applicant respectfully requests reconsideration of this application in light of the interview.

The Final Office Action rejected claims 1, 2, 7-9, 12 and 13 under 35 U.S.C. §102(b) as anticipated by the cited portions of Tarr et al., U.S. Patent 5,184,179 ("Tarr"). The Final Office Action has rejected claims 3-6, 10, 11, 14, 17-24, 26 and 28 under 35 U.S.C. §103(a) as being unpatentable over the cited portions of Tarr and Official Notice.

### **35 U.S.C. §103(a) Rejection, Tarr**

As noted, the Office Action rejected independent claims 14, 22, and 28 under 35 U.S.C. §103(a) as being unpatentable over Tarr and official notice. To establish a *prima facie* case of obviousness, the prior art references must "teach or suggest all the claim limitations." MPEP §2143.

The Applicants believe significant limitations from the independent claims are neither taught nor suggested in the references. More specifically, neither Tarr nor Official Notice can be relied upon to teach or suggest (1) automatic wireless notification of a service technician, as recited by at least claims 22 and 28, (2) an operations center that communicates the service triggering threshold, as recited by at least claims 14 and 28, or (3) a data capture device at a business machine with a wireless transceiver that transmits a notification to the operations center when the threshold is triggered, as recited at least in claim 28. Applicants respectfully request that the obviousness rejection be withdrawn for these reasons.

1. Automatic Wireless Notification: Tarr cannot reasonably be relied upon to teach *automatic wireless notification of a service technician* in response to receiving notification of a threshold event from the data capture device on a business machine.

There is no *automatic* notification of the service technician, as called for in the claims (Final Office Action, p. 12, ll. 2-3, *citing* Tarr, col. 8, ll. 20-24). Both claims 22 and 28 recite that "**wireless notifying occurs automatically** in response to the notification from the data capture device" (emphasis added).

Moreover, the Office Action dated August 14, 2006 ("Office Action") merely appears to take Official Notice of the wireless aspects of this step (Office Action, p. 12, ll. 6-10). Applicants traverse this Official Notice.

If this rationale is maintained, an express showing of documentary proof is hereby requested to support these elements, as the documentary proof procedure is set forth in MPEP §2144.03. The MPEP provides that Official Notice without documentary evidence is only appropriate in "**rare**" cases, a caveat that was not followed in this instance. MPEP §2144.03(A). "It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known." *Id.*

It is respectfully suggested that automatic wireless notification of a service technician in response to the triggering of a threshold at a business machine is not capable of

instant and unquestionable demonstration as being well-known. Applicants have therefore "specifically point[ed] out the supposed errors in the examiner's action." MPEP 2144.03(C). If this rationale is continued, Applicants request documentary proof for this issue.

2. Operations Center: Tarr cannot reasonably be relied upon to teach an *operations center* that *communicates* the service triggering *threshold* to a data capture device on a business machine. Claim 14 for "an operations center [that] determines a threshold related to a service contract and communicates that threshold to one of the plurality of data capture devices." (Claim 28 contains similar limitations).

The Final Office Action relies on a section of Tarr to teach this limitation that clearly does not do so. (Final Office Action, p. 11, ll. 17-19, *citing* Tarr, col. 5, ll. 14-30).

3. Wireless Transceiver at Business Machine: Tarr cannot reasonably be relied upon to teach a data capture device at a business machine with a *wireless transceiver* that *transmits a notification* to the operations center when the *threshold* is triggered.

The Office Action merely appears to take Official Notice of this step (Office Action, p. 12, ll. 6-10). Applicants traverse this Official Notice.

It is respectfully suggested that before the priority date of this Application, attaching a wireless transceiver to data capture device coupled with a business machine was not capable of instant and unquestionable demonstration as being well-known. In the present context, this is yet another novel aspect of a new methodology of managing business machines.

Applicants have therefore "specifically point[ed] out the supposed errors in the examiner's action." MPEP 2144.03(C). If this rationale is continued, Applicants request documentary proof for this issue.

4. Web Interface: Applicants also traverse Official Notice related to the web interface (Office Action, p. 12, ll. 6-10) found throughout the Final Office Action. It is respectfully suggested that before the priority date of this Application, a web interface allowing users to remotely interact with service contract information and thereby modify the threshold

was not capable of instant and unquestionable demonstration as being well-known. Applicants have therefore "specifically point[ed] out the supposed errors in the examiner's action." MPEP 2144.03(C). If this rationale is continued, Applicants request documentary proof for this issue.

**35 U.S.C. §102(b) Rejection, Tarr**

The Office Action rejected independent claim 1 as being anticipated by Tarr. For a valid anticipation rejection, the Office must show that each limitation from the claims appears in a single piece of prior art.

Claim 1 recites "reporting information related to the service contract electronically and automatically to the user." The Final Office Action cites a portion of Tarr specifying notification to the billing computer "operator" when maintenance is required (Final Office Action, p. 3, ll. 15-17, *citing* Tarr, col. 6, ll. 20-24). This part of Tarr clearly does not teach the limitation at issue.

**Remaining Claims**

Because it is asserted that the cited references do not teach the limitations at issue, it is respectfully submitted that independent claims 1, 14, 22, and 28 are allowable for at least the above reasons. Claims 2-13, 17-21, 23, 24, 26 and 28 each depend from the independent claims, and these claims are believed to be allowable for at least the same reasons as given above. Applicants, therefore, respectfully request that the rejection be withdrawn.

**CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

Appl. No. 09/929,398  
Amdt. dated November 21, 2006  
Amendment under 37 CFR 1.116 Expedited Procedure  
Examining Group 3623

PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



Michael L. Drapkin  
Reg. No. 55,127

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: 303-571-4000  
Fax: 415-576-0300

MLD:klb  
60921288 v1